SK

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

CR

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/401,039	09/21/99	OBRADOVICH M	8002.10103

PM82/0706

ALEX L YIP
LONDA & TRAUB LLP
37TH FLOOR
20 EXCHANGE PLACE
NEW YORK NY 10005

EXAMINER	
LOUIS JACQUES,J	
ART UNIT	**PAPER NUMBER**
3661	7
DATE MAILED:	07/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/401,039	OBRADOVICH ET AL.	
	Examiner	Art Unit	
	Jacques H. Louis-Jacques	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☒ Responsive to communication(s) filed on *09 June 2000* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13,16-31 and 34-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *13,16,17,24-31,34,35 and 44-50* is/are allowed.

6)☒ Claim(s) *18-23 and 36-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

1.☐ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 18-23 and 36-43 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 21-39 and 1-20 of prior U.S. Patent No. 6,009,355. This is a double patenting rejection.

The doctrine of double patenting, as set forth in the MPEP seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. Although, generally, a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in a parent application under 35 U.S.C. 121, in the present case, the present application claims the same subject matter as in the parent application.

As stated in the MPEP, where the claims of an application are *substantively* the same as those of a first patent, they are barred under 35 U.S.C. 101 - the statutory basis for a double patenting rejection. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101. The term "same invention," in this context, means an invention drawn to identical subject matter. Miller v. Eagle Mfg. Co., 151 U.S. 186 (1894); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

It is found that the claims in present application could be literally infringed without literally infringing corresponding claims in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). The mere fact that the preambles of the claims of the present application are differently worded , they still define the same invention as the above-mentioned patent.

Thus, the double patenting rejection is proper.

Allowable Subject Matter

3. Claims 13, 16-17, 24-31, 34-35 and 44-50 are allowed.

The prior art fail to teach the plurality of predetermined temperature ranges corresponding to the geographical regions and selecting a temperature range/limit based on the geographical position of the vehicle and the current time so as to operate the climate control. Accordingly, the abovementioned claims define over the prior art of record.

Response to Amendments and Arguments

4. The amendments and arguments filed therewith on June 9, 2000 have been entered and carefully considered by the examiner.

Applicant's arguments have been fully considered but they are not persuasive.

In re Vogel, as supplied by applicant, it is stated that "claims may be differently worded and still define the same invention". The court went on and gave some examples. A claim reciting a length of "thirty-six inches' defines the same invention as a claim reciting a length of "three feet' if all other limitations are identical." In the present case, all other limitations being identical, "the operating a function in a vehicle" recited in the preamble of the present application is identical to the "accessing information about a given aspect of the said vehicle" recited in the preamble of the '335 patent. Because the same invention is being claim twice, 35 USC 101 forbids the grant of a second patent, regardless of the presence of absence of a terminal disclaimer. In applying the test as set forth in In re Vogel, it is found that the claims of the present application could not possibly "literally infringed without literally infringing the claims of the '335 patent..

As to the prior art rejection, it is found upon further consideration that the prior art does not teach the selection of a temperature range/limit based on the geographical position of the vehicle and the current time.

In light of the foregoing, the 35 USC 102 rejection has been withdrawn and the double patenting rejection is sustained. Accordingly, this office action is made final.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,203,499	Knittel	Apr. 1993
5,919,239	Fraker et al	Jul. 1999

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H. Louis-Jacques whose telephone number is (703) 305-9757. The examiner can normally be reached on M-Th, 8:30 AM - 5:00 PM (Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-8623 for regular communications and (703) 308-8623 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1111.

Jacques H. Louis-Jacques
Primary Examiner
Art Unit 3661

/jlj
July 2, 2000

Jacques Louis-Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER